



10 APR 2007

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In re Application of
GOLDSON, et al.
U.S. Application No.: 10/562,717
PCT No.: PCT/NZ04/00137
Int. Filing Date: 01 July 2004
Priority Date: 03 July 2003

Attorney Docket No.: JAW-101/PCT/US
For: A METHOD OF AND APPARATUS FOR
DETECTING THE PRESENCE OF SIGNATURE
VOLATILE COMPOUNDS FROM MATERIALS
IN A CONFINED ENVIRONMENT

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to the applicant's "Petition Under 37 CFR 1.47 Filing When an Inventor Refuses to Sign" filed 18 September 2006 in the United States Patent and Trademark Office (USPTO) to accept the application without the signature of joint inventor Terrance John Braggins.

BACKGROUND

On 01 July 2004, applicant filed international application PCT/NZ04/00137 which claimed priority to an earlier application filed 03 July 2003. A copy of the International Application was forwarded to the United States Patent and Trademark Office (USPTO) from the International Bureau (IB) on 13 January 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 03 January 2006.

On 23 December 2005, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee and an Information Disclosure Statement.

On 14 April 2006, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 18 September 2006, applicant filed the present petition under 37 CFR 1.47

accompanied by a petition for a three-month extension of time and certification under 37 CFR 1.8 that the response was deposited for mailing on 13 September 2006. As such, the response is considered timely filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items (1) and (3) above.

Regarding item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature."

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47... The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as Internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should include a statement of facts. It is important that the statement contain facts as opposed to conclusions.

Applicant has not included a firsthand statement that the non-signing inventor was mailed a complete set of application papers. Thus, it is not possible to take the inventor's subsequent silence as a refusal to cooperate as there is a question as to whether the mailing address used was correct and a complete set of application papers was mailed to Mr. Braggins. In addition, applicant has not provided any exhibits to support the contention that Mr. Braggins has not responded to postal and telephone communications.

Regarding item (4), while applicant has submitted a declaration signed by the remaining inventors on their own and on behalf of the non-signing inventors, the declaration does not comply with 37 CFR 1.497. The declaration contains two pages numbered "Page 2 of 2." This suggests that the enclosed declaration was constructed from numerous complete declarations or that the inventors forwarded to counsel only the signatures pages of the declaration. Either alternative renders the submitted declaration defective under 37 CFR 1.497. While each inventor need not execute the same oath or declaration, where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. (See MPEP 201.03 B. Oath or Declaration.)

In light of the above it is not possible to grant applicant's petition under 37 CFR 1.47(a) at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED without prejudice.**

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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